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09/955,963	09/20/2001	Hiroshi Sumiyama	018775-842	1910

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EXAMINER	
HANG, VU B	

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
03/16/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/955,963	SUMIYAMA ET AL.	
	Examiner	Art Unit	
	Vu B. Hang	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 January 2011*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,8-12 and 16-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,8-12 and 16-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 September 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

- This office action is responsive to the Request for Continued Examination filed on 01/10/2011.
- Claims 1-4, 8-12 and 16-28 are pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/10/2011 has been entered.

Response to Arguments

2. Applicant's arguments filed 01/10/2011 have been fully considered but they are not persuasive.

3. The applicant argues that the previously cited prior art reference, Takahashi et al. (US Patent 6,424,429 B1), fails to disclose "a third key that constitutes an element of a user interface that is displayed to a user, and which a user can press to input an instruction to re-read data that has been transferred to memory." In response, the examiner points out that Takahashi discloses a user interface that includes a call key in which a user can press and retrieve image data that has been stored in memory (see Fig.21 (62) and Col.28, Line 23-36).

The call key 62 of figure 21 recalls the stored document from memory 13 of figure 1, and sends the document to an image forming device 11 of figure 1 for processing (see Fig.1 (11,12,13) and Col.28, Line 23-36).

4. The applicant further argues that Takahashi fails to disclose wherein "when the first key and second key are pressed, the input device receives the image data, the transfer portion transfers the image data received by the input device, and the printing device forms an image based on the image data received by the input device." In response, the examiner points out that Takahashi discloses a first key to accept a data transfer instruction to transfer the image data received by the input device to the memory- incorporating apparatus (see Fig.3 (23c), Col.12, Line 2-16 and Col.12, Line 56-65); and a second key to accept a start instruction to form the image data received by the input device (see Fig.3 (23d) and Col.9, Line 24-33). When a copy function is selected through one of the keys 23c from the operation panel of figure 3, copy processing is to be performed while a backup copy of the image data is sent to server 12 of figure 1 as a backup file to be archived. Key 23d of figure 3 accepts the instruction to execute the copy function (and sending the backup copy of the image data is to the server).

5. The applicant also argues that Takahashi fails to disclose wherein "when the third key is pressed, the reception portion receives the image data transferred by the transfer portion from the memory-incorporating apparatus." In response, the examiner points out that Takahashi discloses a user interface that includes a call key in which a user can press and retrieve image data that has been stored

in memory (see Fig.21 (62) and Col.28, Line 23-36). The call key 62 of figure 21 recalls the stored document from memory 13 of figure 1, and sends the document to an image forming device 11 of figure 1 for processing (see Fig.1 (11,12,13) and Col.28, Line 23-36). Both the image forming apparatus (multifunction device 11 of figure 1) and the memory-incorporating apparatus (server 12 of figure 1) includes a data transfer/reception portion for transferring and receiving document image data (see Fig.1 (24,25), Fig.6 (49), Col.9, Line 9-13 and Col.11, Line 60-63).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 8-11 and 16-20 rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al. (US Patent 6,424,429 B1).

8. Regarding **Claim 1, 17 and 19**, Takahashi discloses an image forming apparatus connected to a memory-incorporating apparatus having an image memory via network (see Fig.1 (11,12,13) and Col.8, Line 64 - Col.9, Line 8), comprising: an input device for receiving image data (see Fig.1 (11), Fig.2 (26),

Col.9, Line 48 - Col.10, Line 7 and Col.10, Line 43-52); a transfer portion for transferring the image received by the input device to the memory- incorporating apparatus (see Fig.2 (24,25), Col.12, Line 2-16 and Col. 12, Line 56-65); a reception portion for receiving the image data transferred from the memory-incorporating apparatus (see Fig.1 (11,12,13), Fig.2 (24,25,27), Col.10, Line 8-13 and Co1.12, Line 26-42), [Note: Copy machine 11 of figure 11 receives an image stored at server 12 upon a user request.]; a printing device for forming an image (see Fig.1 (11), Fig.2 (27), Col.10, Line 8-25 and Col. 10, Line 43-52); a first key to accept a data transfer instruction to transfer the image data received by the input device to the memory-incorporating apparatus (see Fig.3 (23c), Col.12, Line 2-16 and Col.12, Line 56-65), [Note: When a copy function is selected through one of the keys 23c from the operation panel of figure 3, copy processing is to be performed while a backup copy of the image data is sent to server 12 as a backup file to be archived.]; a second key to accept a start instruction to form the image data received by the input device (see Fig.3 (23d) and Col.9, Line 24-33), [Note: Key 23d of figure 3 accepts the instruction to execute the copy function and sending the backup copy of the image data is to the server.]; and a display portion for displaying a third key to accept a reread instruction to reread the image data transferred by the transfer portion from the memory-incorporating apparatus (see Fig.6 (44), Fig.21 (62) and Col.28, Line 23-36), wherein when the first key and second key are pressed, the input device receives the image data, the transfer portion transfers the image data received by the input device, and the printing device forms an image based on the image data received by the

input device (see Fig.3 (23c,23d), Col.9, Line 24-33, Col.12, Line 2-16 and Col.12, Line 56-65), wherein the display portion displays the third key after the transfer portion transfers the image data received by the input device (see Fig.6 (44), Fig.21 (62) and Col.28, Line 23-36), [Note: the third key is the call key 62 of figure 21 for recalling an image data stored at server 12 of figure1 for processing at the multifunction device 11 of figure 1.], and wherein when the third key is pressed, the reception portion receives the image data transferred by the transfer portion from the memory-incorporating apparatus and the printing device forms the an image based on the image data received by the reception portion (see Fig.6 (44), Fig.21 (62) and Col.28, Line 23-36). [The call key 62 of figure 21 recalls the stored document from memory 13 of figure 1, and sends the document to an image forming device 11 of figure 1 for processing (see Fig.1 (11,12,13) and Col.28, Line 23-36). Both the image forming apparatus (multifunction device 11 of figure 1) and the memory-incorporating apparatus (server 12 of figure 1) includes a data transfer/reception portion for transferring and receiving document image data (see Fig.1 (24,25), Fig.6 (49), Col.9, Line 9-13 and Col.11, Line 60-63).]

9. Regarding **Claims 2 and 10**, Takahashi further discloses a retrieval portion for retrieving the memory-incorporating apparatus (see Fig.2 (24,25), Col.12, Line 2-16 and Col.12, Line 56- 65), wherein the retrieval portion retrieves the memory-incorporating apparatus when the first key is pressed (see Fig.3 (23c), Col.12, Line 2-16 and Co1.12, Line 56-65), [Note: When a copy function is selected through one of the keys 23c from the operation panel of figure 3, copy

processing is performed while a copy of the image data is sent to server 12 as a backup file to be archived.]

10. Regarding **Claims 3 and 11**, Takahashi further discloses wherein when the retrieval portion identifies the memory-incorporating apparatus (see Fig.1 (11,12,13), Fig.2 (24,25) and Col. 12, Line 2-12), the transfer portion transfers the image data received by the input device to the memory-incorporating apparatus identified by the retrieval portion (see Fig.2 (24,25), Col.12, Line 2-16 and Col.12, Line 56-65).

11. Regarding **Claims 8 and 16**, the rationale provided for the rejection of Claim 1 is incorporated herein.

12. Regarding **Claims 9, 18 and 20**, Takahashi discloses an image forming apparatus connected to a memory-incorporating apparatus having an image memory via network (see Fig.1 (11,12,13) and Col.8, Line 64 – Col.9, Line 8), comprising: a reading device for creating image data by reading an image document (see Fig.1 (11), Fig.2 (26), Col.9, Line 48 - Col.10, Line 7 and Col.10, Line 43-52); a buffer for holding the image data created with the reading device (see Fig.2 (26,28) and Col.9, Line 9-23); a printing device for forming an image (see Fig.1 (11), Fig.2 (27), Col.10, Line 8-25 and Col.10, Line 43-52); a transfer portion for transferring the image data created by the reading device to the memory-incorporating apparatus (see Fig.2 (24,25), Col.12, Line 2-16 and Col. 12, Line 56-65); a reception portion for receiving the image data transferred from the memory-incorporating apparatus (see Fig.1 (11,12,13), Fig.2 (24,25,27), Col.10, Line 8-13 and Col.12, Line 26-42), [Note: Copy machine 11 of figure 11

receives an image stored at server 12 upon a user request.]; a first key to accept a data transfer instruction to transfer the image data created by the reading device to the memory-incorporating apparatus (see Fig.3 (23c), Col.12, Line 2-16 and Col.12, Line 56-65), [Note: When a copy function is selected through one of the keys 23c from the operation panel of figure 3, copy processing is to be performed while a backup copy of the image data is sent to server 12 as a backup file to be archived.]; a second key to accept a start instruction to form the image data created by the reading device (see Fig.3 (23d) and Col.9, Line 24-33), [Note: Key 23d of figure 3 accepts the instruction to execute the copy function and sending the backup copy of the image data is to the server.]; and a display portion for displaying a third key to accept a reread instruction to reread the image data transferred by the transfer portion from the memory-incorporating apparatus (see Fig.6 (44), Fig.21 (62) and Col.28, Line 23-36), wherein when the first key and second key are pressed, the reading device creates the image data, the transfer portion transfers the image data created by the reading device, and the printing device forms an image based on the image data received by the reading device (see Fig.3 (23c,23d), Col.9, Line 24-33, Col.12, Line 2-16 and Col.12, Line 56-65), wherein the display portion displays the third key after the transfer portion transfers the image data created by the reading device (see Fig.6 (44), Fig.21 (62) and Col.28, Line 23-36), [Note: the third key is the call key 62 of figure 21 for recalling an image data stored at server 12 of figure1 for processing at the multifunction device 11 of figure 1.], and wherein when the third key is pressed, the reception portion receives the image data transferred by the transfer

portion from the memory-incorporating apparatus and the printing device forms the an image based on the image data received by the reception portion (see Fig.6 (44), Fig.21 (62) and Col.28, Line 23-36). [The call key 62 of figure 21 recalls the stored document from memory 13 of figure 1, and sends the document to an image forming device 11 of figure 1 for processing (see Fig.1 (11,12,13) and Col.28, Line 23-36). Both the image forming apparatus (multifunction device 11 of figure 1) and the memory-incorporating apparatus (server 12 of figure 1) includes a data transfer/reception portion for transferring and receiving document image data (see Fig.1 (24,25), Fig.6 (49), Col.9, Line 9-13 and Col.11, Line 60-63).]

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahasi et al. (US Patent 6,424,429 B1) in view of Nishiyama et al. (US Patent 6,067,168).

15. Regarding **Claims 4 and 12**, Takahashi discloses the image forming apparatus of Claims 1 and 9, but fails to disclose a warning device for informing a user that the retrieval portion cannot identify a memory-incorporating apparatus.

Takahashi, however, teaches using a graphical user interface for communicating with the memory-incorporating apparatus (see Fig.3 and Col.9, Line 24-33). Nishiyama discloses an image forming apparatus that includes a warning device for displaying a message informing a user the presence of an external memory-incorporating device (see Fig.16 (S37), Fig.17a (121a) and Col.18, Line 43- 49).

16. Takahashi and Nishiyama are combinable because they are from the same field of endeavor, namely image data processing apparatuses. At the time of the invention, it would have been obvious for one skilled in the art to include to Takahashi's image forming apparatus a warning device for informing a user that the retrieval portion cannot identify a memory- incorporating apparatus. The motivation would be to notify a user that an external memory- incorporating device is not present for image transferring.

17. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahasi et al. (US Patent 6,424,429 B 1) in view of Anai (US Patent 5,663,800).

18. Regarding **Claim 21**, Takahasi discloses the image forming apparatus as described in Claim 1, but fails to disclose wherein the image forming apparatus does not have an image memory. Takahashi, however, discloses transferring the image data to an external memory-incorporated device for data storage and backup (see Fig.1 (11,13,16) and Col.8, Line 61 - Col.9, Line 8), and teaches that retrieving the stored image data from the external memory- incorporated device whenever required enables easy retrieval of image data without requiring complicated operations (see Col.2, Line 19-36). Anai discloses an image forming

apparatus that does not have an image memory (see Fig.3 and Col.2, Line 7-22), and teaches that a no-memory image forming apparatus would enable for the image data to be immediately processed at the image forming apparatus without complicated image data conversions (see Col.2, Line 7-22).

19. Takahashi and Anai are combinable because they are from the same field of endeavor, namely image data processing apparatuses. At the time of the invention, it would have been obvious for one skilled in the art to use an image forming apparatus that does not have an image memory. The motivation would be to increase the image processing efficiency. The a non- memory image forming apparatus would enable for the image data to be immediately processed at the image forming apparatus, without complicated image data conversions (as taught by Anai).

20. Regarding **Claims 22-26**, the rationale provided for the rejection of Claim 21 is incorporated herein.

21. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahasi et al. (US Patent 6,424,429 B1) in view of Matsuyama et al. (US Patent 6,886,028 B1).

22. Regarding **Claim 27**, Takahashi discloses a method forming an image on an image forming apparatus that is connected to an image memory via a network (see Fig.1 (11,12,13) and Col.8, Line 64 – Col.9, Line 8), comprising: displaying a first key relating to a data transfer function on the image forming apparatus (see Fig.3 (23c), Col.12, Line 2-16 and Col.12, Line 56-65), [Note: When a copy function is selected through one of the keys 23c from the operation panel of

figure 3, copy processing is to be performed while a backup copy of the image data is sent to server 12 as a backup file to be archived.]; setting the data transfer function in active state in response to pressing the first key by a user (see Fig.3 (23c), Col.12, Line 2-16 and Col.12, Line 56-65), [Note: When a copy function is selected through one of the keys 23c from the operation panel of figure 3, copy processing is to be performed while a backup copy of the image data is sent to server 12 as a backup file to be archived.]; reading an image from a document and inputting the image data in response to pressing a second key by a user (see Fig.3 (23d) and Col.9, Line 24-33), [Note: Key 23d of figure 3 accepts the instruction to execute the copy function and sending the backup copy of the image data is to the server.]; determining whether the transfer function is set to active state in response to pressing the second key (see Fig.3 (23d) and Col.9, Line 24-33), [Note: Key 23d of figure 3 accepts the instruction to execute the copy function and sending the backup copy of the image data is to the server. The first key indicates copying the transferring the backup copy of the document image data to a server.]; automatically transferring the image data to the memory via the network if the data transfer function is determined to be set to active state (see Fig.3 (23c), Col.12, Line 2-16 and Col.12, Line 56-65); and forming an image based on the input image data (see Fig.2 (26,27) and Col.10, Line 8-25).

23. Takahashi fails to disclose the step of displaying a third key on the image forming apparatus for inputting a command to read an image data that was transferred to the image memory in response to the formation of the image. Takahashi, however, teaches displaying a key at the user interface of a server for

inputting a command to recall an image data that was transferred and stored at an image memory (see Fig.21 and Col.28, Line 23-36). Matsuyama discloses a user interface for a remote client device for retrieving an image stores at a server for image processing at the client device (see Fig.1 (101,103,105,109), Fig.9, Fig.10 and Col.4, Line 36-61).

24. Takahashi and Matsuyama are combinable because they are from the same field of endeavor, namely image data processing methods. At the time of the invention, it would have been obvious for one skilled in eth art to include to the method of Claim 27 the step for displaying a third key on the image forming apparatus for inputting a command to read an image data that was transferred to the image memory in response to the formation of the image. The motivation would be to include to the image forming apparatus a user interface that would enable a user at the image forming apparatus to recall an image that was transferred to and stored at a remote memory device for processing at the image forming device. The third key would allow for a user to retrieve the image data from a remotes storage device for outputting at the image forming device.

25. Regarding **Claim 28**, Takahashi further discloses transferring the image data from an image memory to the image forming apparatus in response to pressing the third key by a user (see Fig.21 (62) and Col.28, Line 23-36); and forming an image at the image forming apparatus based on the image data transferred from the image memory (see Fig.21 (62) and Col.28, Line 23-36).

Conclusion

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571)272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vu B. Hang/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625